

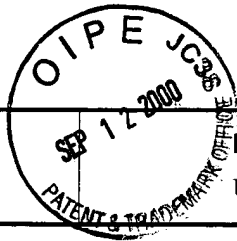
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**TRANSMITTAL LETTER
(General - Patent Pending)**

Docket No.
41766-1

661 72000

In Re Application Of: 'Alfred C. Nichols, et al.



TECH CENTER 1600/2900

Serial No.
09/625,018

Filing Date
7/20/00

Examiner
Unknown

Group Art Unit
1625

Title: **QUINOLIC ACID DERIVATIVES**

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith is:

**Request for Corrected Filing Receipt
Response to Notice to File Missing Parts
Reissue Application Declaration by the Inventor
Verified Statement Claiming Small Entity Status**

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BOARD OF PATENT APPEALS
AND INTERFERENCES

in the above identified application.

- ☐ No additional fee is required.
- ☒ A check in the amount of **\$65.00** is attached.
- ☒ The Assistant Commissioner is hereby authorized to charge and credit Deposit Account No. **501346** as described below. A duplicate copy of this sheet is enclosed.
- ☐ Charge the amount of
- ☒ Credit any overpayment.
- ☒ Charge any additional fee required.

Signature

Dated: **9-12-00**

**Kenneth M. Bush, Reg. No. 40,544
SIROTE & PERMUTT, P.C.
P.O. Box 55727
Birmingham, AL 35255-5727
Phone: (205) 930-5383
Facsimile: (205) 930-5101**

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I certify that this document and fee is being deposited on _____ with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Signature of Person Mailing Correspondence

Typed or Printed Name of Person Mailing Correspondence

CC:

CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)

Applicant(s): Alfred C. Nichols, et al.

Docket No.

41766-1

Serial No.

09/625,018

Filing Date

7/20/00

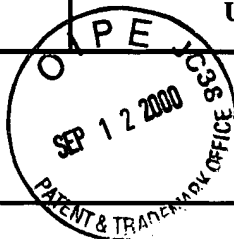
Examiner

Unknown

Group Art Unit

1625

Invention: QUINOLIC ACID DERIVATIVES

I hereby certify that this Request for Corrected Filing Receipt and attachments

(Identify type of correspondence)

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: The Commissioner of Patents and Trademarks, Washington, D.C.

20231-0001 on

9-12-00

(Date)

Donita King

(Typed or Printed Name of Person Mailing Correspondence)

A handwritten signature in cursive script that reads "Donita King".

(Signature of Person Mailing Correspondence)

EK666547102US

("Express Mail" Mailing Label Number)

Note: Each paper must have its own certificate of mailing.

KENNETH M. BUSH

ATTORNEY AT LAW

205.930.5383

kbush@sirote.com

Registered United States Patent and Trademark Office

SIROTE
— & —
PERMUTT
A PROFESSIONAL CORPORATION

September 12, 2000

VIA EXPRESS MAIL

Judge Fred McKelvey
Box Interference
Commissioner of Patents and Trademarks
Washington, DC 20231

Re: Interference No. 104,522
Nichols' Reissue Application documents

Dear Judge McKelvey:

On July 20, 2000, Junior Party Nichols filed a reissue application for U.S. Patent No. 5,783,700 involved in the above-referenced interference. Enclosed are additional documents relating to that reissue application that Nichols filed today. Copies of these documents are being served upon counsel for Senior Party Tabakoff with a copy of this letter.

Very truly yours,



Kenneth M. Bush
FOR THE FIRM

KMB/dk

cc: Talivaldis Cepuritis

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LAW OFFICES AND MEDIATION CENTERS

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POST OFFICE BOX 55727 BIRMINGHAM, ALABAMA 35255-5727

TELEPHONE | 205.930.5100 FAX | 205.930.5101 URL | <http://www.sirote.com>

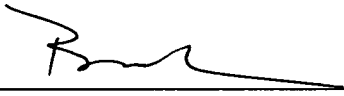
B i r m i n g h a m | H u n t s v i l l e | M o b i l e | M o n t g o m e r y

CERTIFICATE OF SERVICE

I, Kenneth M. Bush, do hereby certify that a copies of the documents titled "REISSUE APPLICATION DOCUMENTS", was served by Express Mail number EK666547093US on this the 12th day of September, 2000, on the following counsel of record:

Attorneys for Tabakoff:

Talivaldis Cepuritis, Esquire
OLSON & HIERL
20 North Wacker Drive
36th Floor
Chicago, IL 60606



Kenneth M. Bush
Attorney for Junior Party
Registration Number 40,544
SIROTE & PERMUTT
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Birmingham, AL 35255-5727
Phone: (205) 930-5100
Facsimile: (205) 930-5101

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CERTIFICATE OF MAILING

I, Kenneth M. Bush, do hereby certify that two copies of the document titled "REISSUE APPLICATION DOCUMENTS", were filed by Express Mail number EK153510414US on this the 12th day of September, 2000, addressed to:

BOX INTERFERENCE
Commissioner of Patents and Trademarks
Washington, DC 20231



Kenneth M. Bush
Attorney for Junior Party
Registration Number 40,544
SIROTE & PERMUTT
P.O. Box 55727
Birmingham, AL 35255-5727
Phone: (205) 930-5100
Facsimile: (205) 930-5101

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09-13-00

file:///c:/APPS/preexam/correspondence/1.htm

FILING RECEIPT



OC00000005319040

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark OfficeAddress: ASSISTANT SECRETARY AND
COMMISSIONER OF PATENT AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
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09/625,018

07/24/2000

1625

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41766

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Kenneth M Bush Esq
Sirote & Permutt PC
PO Box 55727
Birmingham, AL 35255-5727

↳ should be 7/20/00

OCT 1 7 2000

TECH CENTER 1600/2900

Date Mailed: 08/14/2000

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order, and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the PTO processes the reply to the Notice, the PTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Alfred C. Nicholas, Residence Not Provided;

↳ should be
Alfred C. Nicholas, Auburn, AL;
K Lemone Yielding, Tusculumbia, AL

Continuing Data as Claimed by Applicant

THIS APPLICATION IS A REI OF 08/887,627 07/03/1997 PAT 5,783,700

Foreign Applications

If Required, Foreign Filing License Granted 08/11/2000

Title

Quinolic acid derivatives

Preliminary Class

546

Data entry by : BATES, DIANA

Team : OIPE

Date: 08/14/2000

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of

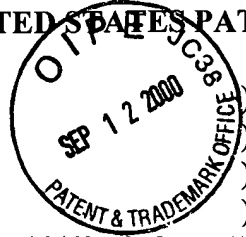
Alfred C. Nichols, et al.

Non-Provisional Serial No.: 09/625,018

Reissue Application of Patent No. 5,783,700

Filed: July 20, 2000

For: QUINOLIC ACID DERIVATIVES



Examiner: Unknown

Group Art Unit: 1625

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TECH CENTER 1600/2900

Sirote & Permutt, P.C.

P.O. Box 55727

Birmingham, Alabama 35255

Assistant Commissioner for Patents

BOX MISSING PARTS

Washington, D.C. 20231

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OCT 16 2000
BOARD OF PATENT APPEALS
AND INTERFERENCES
1100 MAIL ROOM

REQUEST FOR CORRECTED FILING RECEIPT

Sir:

Applicants request that the United States Patent and Trademark Office ("Office") correct the filing date, and name of applicant of the above-referenced filing receipt. The filing date should be July 20, 2000. The name of the applicants should read Alfred C. Nichols, Auburn, Alabama, and K. Lemone Yielding, Tuscumbia, Alabama. Applicants also request the Office to issue a corrected filing receipt. A copy of the Filing Receipt indicating the above-noted changes is being submitted herewith.

This request for Corrected Filing Receipt is being submitted along with the Response to the Notice to File Missing Parts as requested on the face of the Filing Receipt dated August 14, 2000.


The present application is a reissue application of U.S. Patent No. 5,783,700. The inventors' names should be the same as identified in that patent, as shown by the Declaration being filed concurrently with the Response to the Notice to File Missing Parts.

The filing date for this application should be July 20, 2000. As shown by the certificate of mailing, this application was mailed via U.S. Express Mail on July 20, 2000. Pursuant to a June 9, 2000 Order by the Board of Patent Appeals and Interferences (a copy of which is attached) this reissue application was filed directly with the Board rather than the Patent Office. *See* attached Order, p.3. Therefore, the application should be given the date of deposit with the United States Postal Service rather than the date that the Board of Patent Appeals and Interferences delivered the application to the Patent and Trademark Office. 37 C.F.R. § 1.10 (a)

Please contact the undersigned if there are any questions regarding this request.

Respectfully submitted,

SIROTE & PERMUTT, P.C.



By:


Kenneth M. Bush
Registration No. 40,544
(205) 930-5383

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OCT 1 7 2000
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I, Kenneth M. Bush, do hereby certify that the enclosed "REISSUE APPLICATION" for Patent
No. 5,783,700, was filed by Express Mail number EK666547062US on this the 20th day of July, 2000,
addressed to:



Judge Fred E. McKelvey
Board of Patent Appeals and Interferences
Crystal Gateway 2, 10th Floor
1225 Jefferson-Davis Highway
Arlington, VA 22202


Kenneth M. Bush
Attorney for Junior Party
Registration Number 40,544
SIROTE & PERMUTT, P.C.
P.O. Box 55727
Birmingham, AL 35255-5727
Phone: (205) 930-5100
Facsimile: (205) 930-5101

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OCT 1 2000

TECH CENTER 1600/2900

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 20

Filed by: Fred E. McKelvey
Senior Administrative Patent Judge
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

Entered
9 June 2000



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

JUN 9 - 2000

ALFRED C. NICHOLS and K. LEMONE YIELDING,

Junior Party,
(Patent 5,783,700),

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

v.

BORIS TABAKOFF, LAWRENCE SNELL
and PAULA L. HOFFMAN,

Senior Party
(Application 09/171,697).

Patent Interference No. 104,522

BOARD OF PATENT APPEALS
AND INTERFERENCES

200 OCT 19 AM 11:14
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OCT 16 2000

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ORDER

FILING OF PRELIMINARY MOTIONS AND STATEMENTS

A. Conference call

A telephone conference call was held on 7 June 2000, at approximately 2:30 p.m. (1430 hours E.D.T.), involving:

1. Kenneth M. Bush, Esq., and Russell L. Sandidge, Esq., counsel for Nichols;
2. Talivaldis Cepuritis, Esq., counsel for Tabakoff;
and

3. Fred E. McKelvey, Senior Administrative Patent Judge.

B. Relevant discussion during conference call

The principal purpose of the conference call was to set times for taking action during the preliminary motion phase of the interference.

1.

The Nichols list of proposed preliminary motions was reviewed.

Nichols proposed preliminary motions 1, 2, 3 and 4 in essence involve a charge of derivation. As represented during the conference call, the parties had some relation before the applications were filed. No attempt will be made to place on the record the nature of the relation because it is not clear that the board would accurately be able to articulate any relationship. Suffice it to say that the question of who invented what is more likely to come out during the priority testimony phase than through preliminary motions. Moreover, additional discovery (37 CFR § 1.687(c)) and testimony (37 CFR § 1.639(c)) in support of a preliminary motion is not likely to be authorized during the preliminary motion phase, but may be appropriate during the priority testimony phase of the interference.

Nichols proposed preliminary motions 5 and 6 may be filed together and should essentially raise the issue of whether particular patent claims should be designated as not

corresponding to the count. To prevail on the motion, Nichols should establish that the "particular" claims would be patentable over the subject matter of the Tabakoff claims which correspond to the count, assuming that subject matter to be prior art.

Nichols proposed preliminary motion 7 involves addition of a reissue application to the interference. Nichols should file the reissue application directly with the board (preferably by Federal Express addressed in the manner set out in ¶ 3(b) of the NOTICE DECLARING INTERFERENCE). The board will process the application through the Application Division. Failure to file the reissue application directly with the board may result in denial of any motion to add the reissue application to the interference.

Nichols proposed preliminary motion 9 should be made part of any motion to add a reissue application.

Nichols proposed preliminary motion 10 should be made part of Nichols proposed preliminary motion 8.

2.

Tabakoff proposes a preliminary motion for judgment based on (1) alleged lack of enablement (how to make) and (2) alleged failure to describe the best mode.

Tabakoff is ordered to file separate preliminary motions, one addressing enablement and the other addressing best mode.

3.

The parties are advised that in connection with issues involving derivation, inequitable conduct and failure to describe

a best mode the board often--but not always--elects to be present during cross-examination. Accordingly, cross-examination on these issues may be ordered to take place at the board in Arlington, Virginia. A decision on where cross-examination is to take place is generally made after reviewing the preliminary motion or following presentation of evidence on derivation.

C. Time periods associated with preliminary motions

In accordance with discussion during the conference call, and in accordance with times suggested by the parties, the following "Time Periods" as set out in an Appendix to this ORDER are established in this interference:

1. TIME PERIOD 1

The time for filing and serving preliminary motions (37 CFR § 1.636(a)) is set to expire at the end of TIME PERIOD 1.

If no party files a preliminary motion, the parties should place a conference call to the administrative patent judge so that a time for taking testimony or other appropriate action may be set.

Attention is directed to Paragraph 26(f) of the NOTICE DECLARING INTERFERENCE (Paper 1) if a request is made for leave to take testimony to support a preliminary motion.

Attention is directed to Paragraph 26(g) of the NOTICE DECLARING INTERFERENCE (Paper 1) with respect to any preliminary motion for judgment (37 CFR § 1.633(a)) based on inequitable conduct and/or fraud.

2. TIME PERIOD 2

The time for filing and serving preliminary motions pursuant to 37 CFR § 1.633(i) and (j) responsive to a preliminary motion filed by an opponent (37 CFR § 1.636(b)) is set to expire at the end of TIME PERIOD 2.

3. TIME PERIOD 3

The time for filing and serving oppositions to all preliminary motions, including preliminary motions filed pursuant to 37 CFR § 1.633(i) and (j), is set to expire at the end of TIME PERIOD 3.

4. TIME PERIOD 4

The time for filing replies to all oppositions is set to expire at the end of TIME PERIOD 4.

5. TIME PERIOD 5

The time for filing:

- a. if a party desires a hearing on preliminary motions, a request for a hearing;
- b. motions to suppress evidence relied upon by an opponent in connection with preliminary motions (compare 37 CFR § 1.656(h)); and
- c. observations by a cross-examining party with respect to cross-examination of an opponent's affiants following filing of replies

is set to expire at the end of TIME PERIOD 5.

6. TIME PERIOD 6

The time for filing:

- a. oppositions to an opponent's motion to suppress and
- b. a response to observations by a cross-examining party with respect to cross-examination of an opponent's affiants following filing of replies

is set to expire at the end of TIME PERIOD 6.

7. TIME PERIOD 7

The time for filing replies to oppositions to motions to suppress is set to expire at the end of TIME PERIOD 7.

The parties are authorized to stipulate different times (earlier or later, but not later than TIME PERIOD 7) for TIME PERIODS 1 through 6, provided, a notice is filed with the board as soon as practical after any agreement is reached. The notice should be in the form of a photostatic copy of the Appendix attached to this ORDER with old dates crossed out and new dates inserted by hand.¹ The parties may not stipulate an extension of TIME PERIOD 7.

¹ The purpose of this requirement is to make it easy for personnel at the board to determine the changes in dates agreed to by the parties.

D. Deposition transcripts

Transcripts of depositions of cross-examination and/or depositions taken under 35 U.S.C. § 24 shall be served, but not filed with the board until the exhibits are filed.

E. Serving exhibits relied upon in preliminary motions

An exhibit, including an affidavit, relied upon in connection with preliminary motions, oppositions, and replies shall be served (but not filed with the board) with the preliminary motion, opposition, reply or affidavit in which the exhibit is first mentioned.

F. Time for filing the record in connection with preliminary motions

TIME PERIOD 8

On or before the expiration of TIME PERIOD 8,

1. An original and three copies of each exhibit, including affidavits, and deposition transcript should be filed with the board. Exhibits should be filed in an accordion folder, box or other folder containing all exhibits in numerical order (the copies of exhibits should be submitted in like fashion in an accordion type or other folders).

2. Three copies of preliminary motions, oppositions and replies previously filed should be filed with the board, with each copy of each motion, its opposition and its reply and any observations and any response to observations being filed in a separate folder.

3. Any ZIP® disk and/or CD-ROM which a party elects to file.

G. Preliminary statements

The time for filing (but not serving) preliminary statements (37 CFR § 1.621(a), see also 37 CFR § 1.627(a)) is the same as the time for complying with TIME PERIOD 1.

The time for filing the notice required by 37 CFR § 1.621(b) is the same as the time for complying with TIME PERIOD 1.

A junior party who does not file a preliminary statement shall not have access to the preliminary statement of any other party. 37 CFR § 1.631(b). Without further order of the board, within one (1) week after the date for filing preliminary statements, a copy of a party's preliminary statement shall be served on each opponent who served a notice under 37 CFR § 1.621(b).

McK

FRED E. McKELVEY
Senior Administrative Patent Judge

9 June 2000
Arlington, VA

ORDER
FILING OF PRELIMINARY MOTIONS AND STATEMENTS

1.	TIME PERIOD 1 Filing preliminary motions	30 August 2000
2.	TIME PERIOD 2 Filing Rule 633(i) and Rule 633(j) preliminary motions	13 September 2000
3.	TIME PERIOD 3 Filing of oppositions to all preliminary motions	8 November 2000
4.	TIME PERIOD 4 Filing of replies	20 December 2000
5.	TIME PERIOD 5 Filing of request for hearing; motions to suppress and observations with respect to cross-examination	17 January 2001
6.	TIME PERIOD 6 Filing of oppositions to motions to suppress and any response to observations with respect to cross- examination	31 January 2001
7.	TIME PERIOD 7 Filing replies to oppositions to motions to suppress	14 February 2001
8.	TIME PERIOD 8 Filing the record	28 February 2001

- 9 -

104,522

cc (via First Class Mail):

Attorney for Nichols
(real party in interest
are the named inventors):

Kenneth M. Bush, Esq.
Russell L. Sandidge, Esq.
SIROTE & PERMUTT, P.C.
2311 Highland Ave. South
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Attorney for Tabakoff
(real party in interest
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Chicago, IL 60606

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E-mail: olsonhierl@aol.com

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Security enhanced document. See back for details.

SIROTE & PERMUTT PC-BIRMINGHAM
2311 HIGHLAND AVE S. #500
BIRMINGHAM, AL 35205


1026

61-479/622
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DATE 09/12/2000

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FOR gov't office filing fee : DKing



MP

⑈001026⑈ ⑆062204792⑆ 8022706954⑈

DOCKET NO. 41766-1

SERIAL NO. 09/625,018

The date stamp of the Patent Office hereon may be considered as the date on which papers indicated below were received.

New Application	<input type="checkbox"/>	Notice of Appeal	<input type="checkbox"/>
Assignment	<input type="checkbox"/>	Appeal Brief	<input type="checkbox"/>
Drawing	<input type="checkbox"/>	Power of Att.	<input type="checkbox"/>
Resp. to O.A.	<input checked="" type="checkbox"/>	Final Fee	<input type="checkbox"/>
Con. Doc.	<input type="checkbox"/>	Check	<input checked="" type="checkbox"/>

Request for Corrected Filing receipt

(Patent Office. Please stamp and return to addressee on reverse side.)